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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,167	07/11/2001	Kenichiro Suetsugu	43888-112	7945
20277	7590	11/04/2004	EXAMINER PHAN, THIEM D	
MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			ART UNIT	PAPER NUMBER

3729

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/889,167

Applicant(s)

SUETSUGU ET AL.

Examiner

Tim Phan

Art Unit

3729

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5.

Applicants' remarks filed on October 19th 2004 retraversing Claims 1, 8, 9 and 16 are hold not to be persuasive.

The Patent Office's position, as stated in the preceding Action, was and continues to be that since least Asao et al (JP07-326834) hereinafter '834 teaches a method of recycling printed circuit board, which reads on all Applicants' Claims 1, 8 and 16.


With respect to Applicants' remarks about lead (Pb): "... a magnitude greater than "0" does NOT necessitate a presence of lead ... is directed to heavy metal content collectively rather than lead specifically." (Cf. Remarks, page 2, lines 13-16), the '834 teaches that the criteria for absolute magnitude value is represented by lead (Pb) affecting the environment (Cf. Detailed Description, Paragraph 8, line 4) where the absolute magnitude of almost "0" of electronic devices can be judged harm-free for landfill use (Cf. Detailed Description, Paragraph 8, line 6), thus any absolute magnitude value greater than "0" is inherently known to have presence of lead, harmful to the environment.

With respect to Applicants' remarks about Claim 16 (Cf. Remarks, page 3), the '834 teaches that the lead containing article is recycled for recovery (Cf. Detailed Description, Paragraph 5, lines 1-4) instead of being released into the environment. and "Asao is concerned only with recycling components ... without differentiation to lead" (Cf. Remarks, page 3, lines 16 & 17), the '834 indeed teaches specifically lead all over the disclosure as element for recycling (Cf. Abstract, line 19; Detailed Description, Paragraph 5, line 1 & Paragraph 8, line 4). Furthermore "... desires recycling of individual components rather than the packaged circuit board as a whole ..." (Cf. Remarks, page 3, line 18-20), the '834 indeed teaches the recycling of the printed circuit board as the main invention (Cf. Title; Abstract; Paragraph 57, Purpose).

It appears that Applicants fail to recognize the scope of the claims when judged in view of the '834. (Cf. MPEP 2111 and In re Geuns, 26 USPQ 2nd 1057 (Fed. Cir. 1993)).

Subsequent dependent claims continue to be rejected as stated in Office Action filed on June 24, 2004 and Responses to

Remarks above.


Tim Phan
Examiner
Art Unit 3729

tp
November 2, 2004


CARL J. ARBES
PRIMARY EXAMINER